

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s):

Gardner G. Courson,
Vincent J. Miraglia,
Patrick T. O'Donnell and
Blane A. Erwin

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Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

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REQUEST FOR REHEARING

This is a Request for Rehearing from the Board Decision on Appeal of September 27, 2010. In the Decision, the Board affirmed the § 112, ¶ 2 rejection of claims 1-4; reversed the §§ 101 and 102 rejections of claims 1-4, the § 112, ¶ 2 rejection of claims 5-12, the § 101 rejection of claims 5-12, the § 112, ¶ 1 rejection of claims 5-12 and the § 102 rejection of claims 5-12; and entered a new ground of rejection under § 103 as to claims 5-12. Appellants request rehearing of the new § 103 rejection of claims 5-12 and the claims 1-4 § 112, ¶ 2 rejection.

Appellants thank the Board for its detailed consideration of the appeal to date, particularly given the voluminous, repetitive and confusing nature of the Examiner's Answer.

New Ground of Rejection of Claims 5-12

For ease of reference, Appellants provide claim 5 of the present specification.

5. A tool for recommending a decision in litigation, the tool comprising:
interfaces for gathering selected information relevant to the decision;
storage for the gathered selected information;
weighting values associated with each element of selected information;
an analyzer for using the stored selected information and the associated weighting values to determine a resultant value;
resultant values associated with various decision options; and
a recommendation element using the determined resultant value and the associated decision options to provide a recommended decision.

Appellants also provide the findings of fact used to form the § 103 rejection.

1. Figure 1A and 1B of the instant application are prior art and depict a flowchart of the methodology involved in making an assessment in an employment lawsuit. Specification [00003] and [00016].
2. Figure 1A depicts steps of gathering information, such as “Obtain Plaintiff’s Medical Release of Records for Compensatory Analysis” and “On-site Investigation.”
3. Figure 1B includes a step of “Analyze: Success/Vulnerability of Case and Damage Ratings.
4. Figure 1B includes a step of “Present Analysis and Recommendation to Client.”
5. The Specification states: “Each of the data values includes a particular value which is then used in a weighted analysis as derived by an experienced lawyer.” Specification [00034]. *See also* Specification [00029],
6. Newell teaches that computer based tools that store litigation information in databases are known. Newell [0004] and [0103].
7. Newell teaches using a computer based user interface for accessing litigation information. Newell [0006] and [0101].

Appellants begin by objecting to one statement in the Decision. On page 14 the Decision states, “Appellants also admit that it is within the general knowledge of an experienced lawyer to derive a weighted analysis.” Appellants first note that the ¶¶ 0029 and 0034 referenced in FF 5 are from the Detailed Description of the Preferred Embodiments and are never admitted as being prior art. This is in contrast to Figs. 1A and 1B which are described in the Background of the Invention and admitted prior

art. Appellants also note that the Decision sentence mischaracterizes the relevant sentences in ¶¶ 0029 and 0034. The specification sentences indicate that experienced lawyers provide the weighting factors and scores for use in the embodiments. Just because experienced lawyers are used to determine the weighting factors and scores, this is not an admission that “it is within the general knowledge of an experienced lawyer to derive a weighted analysis,” particularly when all of the claim terms and limitations are properly considered, as discussed next.

Proceeding to the substantive rejection, one of the fundamental requirements of a proper rejection is that it addresses each of the elements of the claimed invention. The new ground of rejection in the Decision failed to do this. The final four elements of claim 5 are specific, interrelated and not mentioned in the rejection. The apparent totality of the discussion related to these four elements, weighting values, an analyzer using the weighting values¹, resultant values and a recommendation element, is apparently “Appellants also admit that it is within the general knowledge of an experienced lawyer to derive a weighted analysis.” This sentence does not discuss the specific claim elements of weighting values, an analyzer, resultant values and a recommendation element. As discussed above, this sentence improperly treats specification portions as an admission, so at the most extreme, it is not even evidence that can be used in rejecting the claim.

Even if the Decision sentence is used, it does not address the specific elements. There is no indication that weighting values associated with each element of selected information are ever developed. There is no indication that an analyzer, as a discrete item, is ever developed. There is no indication that resultant values associated with various decision options are ever developed. There is no

¹The Decision on page 9 notes that the Examiner considered “weighting values” to be a method step and that Appellants did not challenge the construction. Appellants disagree. Appellants refer to p. 13 of the Appeal Brief, the § 112, ¶ 1 Enablement portion of the rejection, where the first full paragraph discusses the weighting values and the second paragraph discusses the use of the weighting values. They are next addressed in the § 112, ¶ 1 utility portion at p. 15, for example “The weighting values are combined to form a score, which is translated to a recommendation.” These are just a few examples where the meaning of the term “weighting values” was discussed. The term is used throughout both the Appeal Brief and Reply Brief in a very consistent manner, always that “weighting values” are numerical values, not a step or method. The specification is similarly replete with uses, all relating to numerical values, not steps, for the term. Indeed, the Decision made no comment on the term “resultant values,” which are also numerical values, just like “weighting values.”

Further, analysis of the full element clearly shows that “weighting values” is a single term, with “weighting” being an adjective applied to “values.” There is no word between “weighting” and “values” that could indicate that “weighting” is operating as a verb, which would be necessary to have the element be a step. If words like “of” or “the” were present, then “values” would be the object of the verb “weighting”, but no such words are present.

Thus, Appellants described the term “weighting values” repeatedly, each time clearly indicating the element was not a step, in responding to the § 112, ¶ 1 rejections, those arguments apply. Further, proper English language analysis of the element shows that the element is not a step but an object of the verb “comprising.”

indication of a recommendation element, as a discrete element, which uses the resultant value and the decision options to provide a recommended decision is ever developed.

Further, there is no indication that the elements are combined in the interrelated order defined in the claim. It is well known that even if each element is individually present, the claimed interrelationships must also be shown in a proper rejection. The Decision does not do that.

Further, Figs. 1A and 1B and the related description are not sufficient to show at a lawyer develops these specified values or has the analyzer or recommendation element, which use the values as claimed. Appellants submit that the Decision has not provided proper evidence to support the conclusion of the Decision statement.

The Decision on page 15 quotes several cases that appear to be the underlying reason for the rejection, namely “is not ‘invention’ to broadly provide a mechanical or automatic means to replace manual activity which has accomplished the same result.” But Appellants are not claiming this is the invention. The Decision proceeds to further quote *Rundell*:

Appellant argues that his rejected claims rest upon an automatic mechanism. The mere statement that a device is to be operated automatically instead of by hand, without a claim specifying any particular automatic mechanism, is not the statement of an invention

The claim here does specify the particular mechanism being used, namely the weighting values, an analyzer, resultant values and a recommendation element. Therefore Appellants are complying with the particular automatic mechanism requirement of *Rundell*, which particular mechanism was not addressed in the rejection, as discussed above. Thus *Rundell* not only does not support the position of the Decision, it supports Appellants.

The Decision concludes that the purported admissions and the teaching of Newell would have led to the tool of claim 5. But Newell only has some interfaces and storage. The Decision has cited nothing that would allow that person skilled on the art that has been “led to the tool” to combine Newell with the properly useable admitted items (Figs. 1A and 1B). The Decision does not provide any indication of how Figs. 1A and 1B could be combined with Newell to produce claim 5. Figs. 1A and 1B are a series of mental steps. Newell is a specific computer system. They are not directly combinable and the Decision has not cited any reference to allow the combination to be produced. Thus the Decision is inadequate in this regard as well.

For these numerous reasons the new ground of rejection under § 103 presented in the Decision is improper and should be withdrawn.

Claim 1-4 § 112, ¶ Rejection

The Decision affirmed the § 112, ¶ 2 rejection of claims 1-4. Appellants request reconsideration of that decision.

The Decision stated that the recitation of an entry field and a menu does not require a GUI. Appellants respectfully submit that a portion of the entry field element was not considered in making this statement and no reference was made to the specification.

The entry field element is more completely: “an entry field available on a plurality of views not directly related to discovery....” Appellants submit that when the language “available on a plurality of views not directly related to discovery” is considered, the graphical user interface nature is present. The term “views,” particularly when combined with “plurality of,” would indicate to one skilled in the art the graphical nature of the entry field. This becomes more apparent when the specification is considered. The Decision appears to address the claim in the abstract, without any reference to the specification. But one skilled in the art would use the specification to be apprised of the claim terms. Appellants refer to MPEP 2111, which opens by quoting the en banc decision in *Phillips v. AWH Corp.*

The Patent and Trademark Office (“PTO”) determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction “in light of the specification as it would be interpreted by one of ordinary skill in the art.”

This use of the specification was addressed in the Reply Brief (Reply Br. 6-8). Appellants refer to ¶ 0051 of the specification, provided here for simplicity.

One of the important phases of a lawsuit is the discovery process. It is often long and complicated and used to gather much of the evidence and facts present for the particular case. It is common to have sample or form discovery materials available, particularly when the law firm is relatively experienced in a given area. However, in each particular case there are particular individualized discovery questions or relevant information which must be gained. Further, it is often common that these particular individualized questions are only developed as the evidence is being reviewed by the attorney and/or paralegal. To remember this particular question which has been developed during this document review, the person jots it down on a piece of paper or a note which is stuck on their monitor. Then during the course of the lawsuit the notes are lost or they fall off the monitor and are swept away. Thus this highly transitory and relevant information is lost and discovery is somewhat hampered. Review of Figure 99 and 100 illustrates that the tool includes a method of gathering and maintaining these particular transitory discovery questions. It is noted in the upper right-hand corner of the exemplary screen shots that there is a button indicated “Discovery Generator.” Clicking on Discovery Generator brings up a drop down box shown in Figure 100. The class or category of discovery is indicated, an entry is made to whom the particular discovery is directed and then the ultimate question is entered. This question is then saved into a collection as shown on Figure 99.

This portion of the specification describes the entry field (the “Discovery Generator” button) on the plurality of views (exemplary screen sheets) and the menu (the drop down box of Fig. 100). One skilled

in the art that has reviewed the specification and considered it in trying to determine the meanings of the elements would conclude that the elements relate to a GUI, which is classically an apparatus. Only by ignoring the specification completely, as clearly done in the Examiner's Answer and apparently done in the Decision, would one have trouble reaching this conclusion. A simple review of the specification, as required, clears it all up.

The Decision also addresses the remark in the Appeal Brief that the discovery production mechanism is "a generally computer-implemented process." The Decision interprets this as being a step, not as an apparatus. A better way of phrasing the point than used in the Appeal Brief would be "a computer which implements a process" or "a computer implementing a process." This better phrasing is completely supported when the specification, ¶ 0052, in particular, is considered. The Figures show numerous screen shots of a computer display. The buttons and drop downs indicate a computer with a GUI. The specification discusses the tool selecting the questions and merging them with discovery materials and then developing an output with word processing tools, another reference to a computer and specific software. When this revised phrasing, "a computer which implements a process," is considered, the apparatus nature of the element is clear.

Appellants respectfully submit that when all of the clauses in the claim elements are considered in light of the specification, one skilled in the art would reasonably construe claim 1 to be an apparatus.

II. Conclusion

For the reasons stated above, Appellants respectfully submit that the § 103 rejection of claims 5-12 and the claims 1-4 § 112, ¶ 2 rejection should be reversed.

In the course of the foregoing discussions, Appellants may have at times referred to claim limitations in shorthand fashion, or may have focused on a particular claim element. This discussion should not be interpreted to mean that the other limitations can be ignored or dismissed. The claims must be viewed as a whole, and each limitation of the claims must be considered when determining the patentability of the claims. Moreover, it should be understood that there may be other distinctions between the claims and the prior art which have yet to be raised, but which may be raised in the future.

Respectfully submitted,

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/Keith Lutsch/
Keith Lutsch
Reg. No. 31,851
Email: WCPatent@counselip.com
Wong, Cabello, Lutsch,
Rutherford & Brucculeri, L.L.P
20333 State Highway 249, Suite 600
Houston, TX 77070
Voice: 832-446-2405